

REMARKS / ARGUMENTS

I. General Remarks and Disposition of the Claims

Applicants hereby request continued examination, in accordance with 37 C.F.R. § 1.114. Applicants respectfully request that the preliminary amendment herein be entered, and further request consideration of the claims in light of the amendments and remarks contained herein.

Claims 1-32 are pending. Claim 10 is currently amended. Applicants thank the Examiner for his careful consideration of this application and acknowledge Examiner's designation of claims 1-9 and 18-32 as being drawn to allowable subject matter.

II. Remarks Regarding 35 U.S.C. § 102(b) Rejections

Claims 10-12 stand rejected under 35 U.S.C. § 102(b) as being anticipated by U.S. Patent No. 3,965,686 issued to Saito *et al.* [hereinafter *Saito*].

In order to form a basis for a rejection under 35 U.S.C. § 102(b), a prior art reference must disclose each and every element as set forth in the claim. *See* MANUAL OF PATENT EXAMINING PROCEDURE § 2131 (2004). With respect to claims 10-12, the examiner states as follows:

In response to applicant's arguments concerning the 102b rejection in view of Saito of claims 10-12, the recitation "for controlling flowback of proppants formed in a fracture of a subterranean formation" has not been given patentable weight because the recitation occurs in the preamble. A preamble is generally not accorded any patentable weight where it merely recites the purpose of a process or the intended use of a structure, and where the body of the claim does not depend on the preamble for completeness but, instead, the process steps or structural limitations are able to stand alone. See *In re Hirao*, 535 F.2d 67, 190 USPQ 15 (CCPA 1976) and *Kropa v. Robie*, 187 F.2d 150, 152, 88 USPQ 178, 481 (CCPA 1951).

(Advisory Action at 2). Applicants respectfully submit, however, that *Saito* does not disclose each limitation recited in Applicants' as-amended claims 10-12.

In particular, *Saito* fails to disclose the limitation of claim 10 wherein the in-situ filter "when placed in a fracture of a subterranean formation prevents the flowback of at least one proppant into a wellbore penetrating the subterranean formation." Because *Saito* does not disclose this limitation, Applicants respectfully assert that *Saito* cannot anticipate claims 10-12 and the claims are therefore allowable. Additionally, because claims 13-17 depend, either

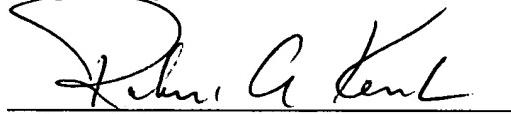
directly or indirectly, from independent claim 10, these dependent claims should be allowed for at least the same reasons. Thus, Applicants respectfully request withdrawal of the § 102(b) rejection as to claims 10-12, and further request the timely issuance of a Notice of Allowance for these claims.

SUMMARY

In light of the above remarks, Applicants respectfully request reconsideration and withdrawal of the outstanding rejections. Applicants further submit that the application is now in condition for allowance, and earnestly solicit timely notice of the same. Should the Examiner have any questions, comments, or suggestions in furtherance of the prosecution of this application, the Examiner is invited to contact the attorney of record by telephone, facsimile, or electronic mail.

The Commissioner is hereby authorized to debit the Deposit Account of Halliburton Energy Services, Inc., No. 08-0300 (Reference Number HES 2000-IP-008360U1) in the amount of \$790.00 for the RCE fee under 37 C.F.R. § 1.114. Applicants believe that no additional fees are due in association with the filing of this Response. However, should the Commissioner deem that any additional fees are due, including any fees for extensions of time, the Commissioner is authorized to debit the Deposit Account of Halliburton Energy Services, Inc., No. 08-0300, for any underpayment of fees that may be due in association with this filing.

Respectfully submitted,



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Date: October 6, 2005